

UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/841,844 Confirmation No. 5830

Patent No. : 6,537,549 Issued March 25, 2003

Applicant : Edward L. Tobinick

Filed : 05/25/2001

TC/A.U. : 1615

Examiner : CHANNAVAJJALA, LAKSHMI SARADA

37 CFR 1.323 REQUEST FOR CERTIFICATE OF CORRECTION  
OF APPLICANT'S MISTAKE

HONORABLE COMMISSIONER OF PATENTS & TRADEMARKS  
ALEXANDRIA, VA 22313

SIR: 11

The following is a request for a certificate of correction in Serial Number 09/841,844, now Patent Number 6,537,549. A certificate of correction under 35 USC 255 is respectfully requested in the above-identified patent.

At least one error is the fault of the applicant, and, accordingly, \$100.00 is submitted to pay the fee for a Certificate of Corrections (35 USC 255 and 37 CFR 1.323). The errors are minor and their correction would not entail re-examination or constitute new matter, and are readily apparent from the USPTO file histories, attached, and explained below.

The requested corrections are below on Form PTO 1050.

UNITED STATES PATENT AND TRADEMARK OFFICE

**CERTIFICATE OF CORRECTION**

**PATENT NO. : 6,537,549**

**ISSUED : Mar. 25, 2003**

**INVENTOR(S) : Edward L. Tobinick**

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In column 1, lines 5 - 15, please delete the following paragraph:

"This is a continuation-in-part of application Ser. No. 09/826,976, filed on Apr. 5, 2001, now U.S. Pat. No. 6,419,944 which is a continuation-in-part of application Ser. No. 09/563,651, filed on May 2, 2000, was U.S. Pat. No. 6,471,961, which is a continuation-in-part of application Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

and insert therefore:

-- This is a continuation-in-part of application Ser. No. 09/826,976, filed on Apr. 5, 2001, now U.S. Pat. No. 6,419,944, which is a continuation-in-part of application Ser. No. 09/563,651, filed on May 2, 2000, now U.S. Pat. No. 6,471,961, and a continuation-in-part of application 09/666,068, filed on December 11, 2000, now U.S. Pat. No. 6,379,666, which is a divisional of application Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned. --

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION (CONTINUED)**

On the front page of the patent, please delete the following paragraph:

"Continuation-in-part of application No. 09/826,976, filed on Apr. 5, 2001, now Pat. No. 6,419,944, which is a continuation-in-part of application No. 09/563,651, filed on May 2, 2000, was Pat. No. 6,471,961, which is a continuation-in-part of application No. 09/476,643, filed on Dec. 31, 1999, now Pat No. 6,177,077, which is a continuation-in-part of application No. 09/275,070, filed on March 23, 1999, now Pat No. 6,015,557, which is a continuation-in-part of application No. 09/256,388, filed on Feb. 24, 1999, now abandoned. ."

and insert therefore:

-- This is a continuation-in-part of application Ser. No. 09/826,976, filed on Apr. 5, 2001, now U.S. Pat. No. 6,419,944, which is a continuation-in-part of application Ser. No. 09/563,651, filed on May 2, 2000, now U.S. Pat. No. 6,471,961, and a continuation-in-part of application 09/666,068, filed on December 11, 2000, now U.S. Pat. No. 6,379,666, which is a divisional of application Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned. --

MAILING ADDRESS OF SENDER:

PATENT NO. 6,537,549

No. of additional copies: 0

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## **I. STATEMENT OF THE RELIEF REQUESTED - REVISE for '549**

The applicant petitions for acceptance of an unintentionally delayed claim for priority and for entry into this issued application of an amendment to correct the benefit claim under 35 U.S.C. §120.

The chain of priority in 09/826,976 is missing a reference to application 09/666,068. And as explained below, the priority chain should specify that 09/826,976 is a continuation-in-part of 09/666,068.

The priority chain of 09/666,068 (US 6,379,666) is itself the subject of a petition for acceptance of an unintentionally delayed claim for priority, that was filed on March 30, 2010. The Certificate of Correction filed with that petition was issued by the PTO on April 27, 2010; however, the Petition itself has not yet been granted.

The present petition and amendment recite the priority chain of 09/666,068 as it was corrected in the Petition filed March 30, 2010. The material facts recited below pertaining to the file history of 09/666,068 are essentially the same as stated in the earlier Petition, and all identical exhibits in the related petitions have the same exhibit numbers.

In an Amendment submitted herewith, page 1 of the specification (the paragraph starting with "RELATED APPLICATIONS") is amended as follows (marked-up):

This is a continuation-in-part of application No. 09/563,651, filed on May 2, 2000, which is a continuation-in-part now U.S. Pat. No. 6,471,961, and a continuation-in-part of application 09/666,068, filed on December 11, 2000, now U.S. Pat. No. 6,379,666, which is a divisional of application Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned.

## **II. MATERIAL FACTS**

### **A. CHAIN OF APPLICATION FILINGS**

1. On February 24, 1999, the applicant filed Serial No. 09/256,388, with an original U.S. inventor declaration.

2. On September 16, 1999, applicant filed a notice of express abandonment that stated:

"Re: S.N. 09/256,388 Applicant hereby abandons the above-identified application in favor of Appln. S.N. 09/275,070, which has been allowed by Examiner Jarvis."

3. Serial No. 09/275,070 was filed on March 23, 1999, and matured into U.S. 6,015,557 on January 18, 2000. The applicant filed an original U.S. inventor declaration in 09/275,070, which specifically referred to S.N. 09/256,388.
4. Applicant filed Serial No. 09/476,643 on December 31, 1999, which is prior to January 18, 2000, and was therefore co-pending with S.N. 09/275,070. Applicant filed an original U.S. inventor declaration attached to the specification in 09/476,643 that did not refer to any prior applications.
5. Page 1 of the '643 specification, under the heading "RELATED APPLICATION" stated erroneously that "This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 1999." This statement is erroneous because 09/256,388 had been expressly abandoned on September 16, 1999 (before the '643 application was filed) in favor of 09/275,070 which was still pending when the '643 application was filed.
6. On July 21, 2000, applicant filed a "new" (i.e, a second) original U.S. inventor declaration in 09/476,643 that specifically refers to 09/256,388 and to 09/275,070, thus correcting priority and preserving co-pendency throughout all applications in the chain.
7. Serial No. 09/476,643 matured into U.S. 6,177,077 on January 23, 2001. On page 1 of the patent specification, as amended on July 21, 2000, it states "This application is a continuation-in-part of Ser. No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."
8. Applicant initially submitted divisional Ser. No. 09/666,068 (which is the application now being added to the priority chain of the subject application) on September 19, 2000, but later it was accorded the official filing date of December 11, 2000, which date is still prior to January 23, 2001. Thus, divisional 09/666,068 was co-pending with its parent application 09/476,643. The applicant filed the same inventive specification, a copy of the U.S. inventor declaration from 09/476,643, and relied upon that copy of the original inventor declaration to secure the December 11, 2000 filing date.
9. Claims 1 - 23 and 30 - 38 of the subject application (09/826,976) recite methods for inhibiting the action of TNF for treating various medical conditions by administering a TNF antagonist. The specification of application 09/666,068 contains disclosure relating to the claimed methods, and, therefore, the '068 application should be added to the priority chain of the subject application.

9. On 12/06/2000, applicant filed a request for Correction of Filing Receipt in 09/666,068 stating erroneously: "THIS APPLICATION IS A DIV OF 09/476,643, DATED 12/31/1999, WHICH IS A CIP OF 09/256,388, DATED 2/24/1999, ABANDONED." This statement was erroneous because 09/476,643 is actually a continuation-in-part of Ser. No. 09/275,070, and because it cannot be a continuation-in-part of 09/256,388, due to lack of co-pendency, as explained above.

10. On 11/15/2001, the Related Application statement on page 1 of application 09/666,068 was amended by the Examiner (as indicated by handwritten, dated initials) to add the following underlined text: "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned." This statement is erroneous because 09/476,643 is actually a continuation-in-part of Ser. No. 09/275,070, and because it cannot be a continuation-in-part of 09/256,388, due to lack of co-pendency, as explained above.

11. On 02/22/2001, an Official Filing Receipt was issued in 09/666,068 stating "THIS APPLICATION IS A DIV OF 09/476,643, 12/31/1999, PAT 6,177,077 WHICH IS A CIP OF 09/256,388, 2/24/1999, ABANDONED." This statement is erroneous because 09/476,643 is in fact a continuation-in-part of Ser. No. 09/275,070, and it cannot be a continuation-in-part. 09/256,388, due to lack of co-pendency, as explained above.

12. So in 09/666,068, the applicant's request for Correction of Filing Receipt (12/06/2000), the Examiner's amendment to the specification (11/15/2001), and the Official Filing Receipt (03/22/2001) are all incorrect. That is because 09/476,643 is actually a continuation-in-part of Serial No. 09/275,070, while 09/275,070 is a CIP of 09/256,388.

13. As a result of these facts the 09/666,068 application contained an erroneous priority chain, which error was the subject of a Petition filed on March 30, 2010 for acceptance of an unintentionally delayed claim for priority which has yet to be formally granted. However, a Certificate of Correction regarding the priority chain in 09/666,068 was issued on April 27, 2010.

14. Accordingly, application 09/666,068 is properly called a divisional of application Ser. No. 09/476,643, as recited in the Amendment submitted herewith.

15. Applicant filed Ser. No. 09/563,651 on May 2, 2000, which date is prior to January 23, 2001 (when 09/476,643 matured into U.S. 6,177,077), along with an original U.S. inventor declaration signed May 2, 2000 that claims benefit to application 09/476,643. The first page of

09/563,651 did not refer to any related cases. It issued as U.S. 6,471,961 on October 29, 2002. A Certification of Correction was issued May 23, 2006, correcting the priority chain, by claiming benefit to application 09/476,643, related as a CIP.

16. Applicant filed the subject application (09/826,976) on April 5, 2001, with an original U.S. inventor declaration signed April 4, 2001. The first paragraph of the '976 specification contains the priority chain essentially as it appears in the subject issued patent (U.S. 6,419,944)

#### **B. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/826,976**

17. Exhibit 17 is a copy of the 1 page transmittal letter, and page 1 of the specification filed on 04/05/2001 in application 09/826,976. The upper left hand corner of Exhibit 17 has a USPTO date stamp showing "04/05/01" The upper right hand corner shows the USPTO application number "09/826,976."

18. Exhibit 17, page 2 shows the original first sentence of the specification along with the examiner's handwritten amendment dated 03/22/02 revising the priority claim to recite "This is a continuation-in-part of application Ser. No. 09/563,651, filed on May 2, 2000, which is a continuation-in-part of Application Ser. No. 09/476,643, filed on Dec. 31, 1999, now U.S. Pat. No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/275,070, filed on Mar. 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

19. Exhibit 18 is an original U.S. inventor declaration signed April 4, 2001.

20. Application 09/826,976 issued as U.S. 6,419,944.

21. Exhibit 19, page 2 is a printout of columns 1 and 2 of U.S. 6,419,944, showing that the first sentence of the specification recites "This is a continuation-in-part of application Ser. No. 09/563,651, filed on May 2, 2000, which is a continuation-in-part of Application Ser. No. 09/476,643, filed on Dec. 31, 1999, now U.S. Pat. No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/275,070, filed on Mar. 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

22. Exhibit 19, pages 3 - 5 are the claims in U.S. 6,419,944. Claims 1 - 23 and 30 - 38 relate to methods for inhibiting the action of TNF for treating various medical conditions by administering a TNF antagonist.

2. Exhibit 20 is pages 1-29 from the specification of application 09/666,068 as filed, which contains a description of the invention of claims 1 - 23 and 30 - 38 in U.S. 6,419,944, and, therefore, application 09/666,068 should be added to the priority chain of the subject application.
22. **The foregoing facts show that the USPTO records show that application 09/826,976 is a CIP of 09/476,643 and a CIP of 09/666,068.**

#### **C. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/563,651**

23. **Exhibit 20**, page 1 is a copy of the transmittal letter, and first page of the specification filed on 05/02/2000 in application 09/563,651. The upper left hand corner of Exhibit 20 has a USPTO date stamp showing "05/02/00" The upper right hand corner shows the USPTO application number "09/563,651."

24. Exhibit 20, page 2 shows the original first sentence of the specification, which does not include a priority claim.

25. Exhibit 21 is a copy of the original U.S. inventor declaration filed with application 09/563,651, signed May 2, 2000, and claiming benefit to application co-pending application 09/476,643, filed December 31, 1999.

26. Exhibit 22 is a request for Certificate of Correction, filed December 23, 2005, adding a priority claim as follows: "This application is a continuation-in-part of application Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

27. Exhibit 23 is an SPE Response for Certificate of Correction dated March 6, 2006, approving the requested filed December 23, 2005.

28. Exhibit 24 is the Certificate of Correction in U.S. 6,471,961, issued May 23, 2006, showing that the first sentence of the specification recites "This application is a continuation-in-part of Application Ser. No. 09/476,643, filed on Dec. 31, 1999, now U.S. Pat. No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/275,070, filed on Mar. 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

29. **The foregoing facts show that the USPTO records show that application 09/563,651 is a CIP of 09/476,643.**

**D. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/666,068**

30. Exhibit 1 is a copy of the 2 page transmittal letter, and page 1 of the specification filed on 09/19/2000 in application 09/666,068. The upper left hand corner of Exhibit 1 has a USPTO date stamp showing "09/19/00" The upper right hand corner shows the USPTO application number "09/666,068."

31. Exhibit 1, pages 1 and 2, indicate that 09/666,068 was filed as a Rule 60 divisional incorporating the prior specification and inventor declaration. Item 8 is checked, and amends the specification before the first line to recite "division of application number 09/476,643, filed Dec. 31, 1999."

32. Exhibit 1 page 3 shows the original first sentence of the specification, i.e., "This is a continuation-in-part of application Serial No. 09/256,388, filed on February 24, 1999" along with the Examiner's handwritten amendment dated 11/15/2001, revising the priority claim to recite "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned." (marked-up)

33. Exhibit 2, pages 1 and 2 shows the applicant filed a copy of the original U.S. inventor declaration from 09/476,643, signed by Edward L. Tobinick, M.D. on December 29, 1999, and relied upon that copy to secure the December 11, 2000 filing date.

34. Exhibit 2, page 3 shows applicant requested a correction of filing receipt, dated-stamped "12/06/2000," in stating erroneously: "THIS APPLICATION IS A DIV OF 09/476,643, DATED 12/31/1999, WHICH IS A CIP OF 09/256,388, DATED 2/24/1999, ABANDONED."

35. Exhibit 3, pages 3 - 4 show a two page transmittal letter, date-stamped "Dec 11, 2000" filed in response to the Notice to File Missing Parts, listing "A copy of the Declaration from the parent application (U.S. Serial No. 09/476,643)".

36. Exhibit 3, pages 1 is a Official Filing Receipt mailed "01/24/2001." Exhibit 3, page 2 is an Official Filing Receipt mailed "02/22/2001."

37. Application 09/666,068 issued as US 6,379,666.

38. Exhibit 4 is a printout of the first two columns of US 6,379,666.

39. Exhibit 4 shows that the first sentence of USP 6,379,666 recites "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

40. **The foregoing facts show that the USPTO records show that application 09/666,068 is a divisional of 09/476,643.**

### **C. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/476,643**

41. Exhibit 5, pages 1 and 2 shows the original inventor declaration from application 09/476,643, signed by Edward L. Tobinick, M.D., on December 29, 1999. Exhibit 5, page 3 is the first page of the PTO file history for application 09/476,643, stating in the examiner's handwriting verification that "THIS APPLN is a CIP OF 09/275,070 03/23/99 PAT 6,015,557 WHICH IS A CIP OF 09/256,388 02/24/99 ABN"

42. Exhibit 6, page 1 is a one page transmittal letter dated "December 31, 1999 BY EXPRESS MAIL" for a new application showing the filing of an original inventor's declaration. At the upper left is the date "12/31/99" and at the upper right is the serial number "09/476643". Exhibit 6, page 2 shows the first page of the specification, which one can see originally said "This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 19990." This sentence was crossed-out by the examiner.

43. Exhibit 7, page 1 is the first page of the PTO File History, amended in handwriting by the examiner to state "This Appln is a CIP OF 09/275,070 PAT #6,015,557 WHICH IS A CIP OF 09/256,388 02/24/99 ABN." Exhibit 7, page 2 is another copy of the one page transmittal letter dated "December 31, 1999 BY EXPRESS MAIL" for a new application showing the filing of an original inventor's declaration. At the upper left is the date "12/31/99" and at the upper right is the serial number "09/476643". Exhibit 7, page 3 is an inventor declaration filed with the application. Exhibit 7, page 4 shows the first page of the specification as filed, which stated "This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 19990". This sentence was later crossed-out by the examiner.

44. Exhibit 8, page 1 is a Terminal Disclaimer over US 6,015,557, and page 2 is an original inventor declaration claiming benefit of application "09/275,070 March 23, 1999 U.S. Patent No. 6,015,557" and "09/256,388 February 24, 1999 Abandoned"

45 Exhibit 9, page 2 shows the handwritten amendment by the examiner, dated 8/24/2000 changing the first sentence of the specification to recite "This application is a continuation-in-part of Application Serial No. 09/275,070, filed on March 23, 1999, now U.S. Patent 6,015,557, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on February 24, 1999, now abandoned"

47. Exhibit 10 is a printout of the first two columns of US 6,177,077, stating in the first paragraph that "This application is a continuation-in-part of Application Serial No. 09/275,070, filed on Mar 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

48. **The foregoing facts show that the USPTO records show that application 09/476,643 is a continuation-in-part of 09/275,070.**

#### **D. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/275,070**

49. Exhibit 11, page 1 is a transmittal letter dated "March 23, 1999 BY EXPRESS MAIL." Page 2 is the first page of the specification as filed.. Pages 3 and 4 are a copy of the original inventor declaration, claiming benefit under 35 USC 120 to "09/256,388 24 February 1999 pending" signed on 3-20-99 by two inventors, Dr. Edward L. Tobinick, and Arthur Jerome Tobinick. Pages 5 -8 are a copy of a Petition to Make Special filed March 23, 1999. At the upper right on page 5 is the serial number "09/257070" and the date "03/23/99".

50. Exhibit 12 is a printout of the first two columns of US 6,015,557, stating in the first paragraph that "This application is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

51. **The foregoing facts show that the USPTO records show that application 09/275,070 is a continuation-in-part of 09/256,388.**

#### **E. USPTO RECORDS SHOWING THE FILING DATE OF 09/256,388**

52. Exhibit 13, page 3 is a copy of the first page USPTO file history for application 09/256,388, showing "FILING DATE 02/24/99." Pages 1 - 2 show the original inventor declaration, dated February 21, 1999, signed by two inventors, Dr. Edward L. Tobinick, and Arthur Jerome Tobinick. In 09/256,388, inventor "Edward L. Tobinick, M.D." is the same person as "Dr. Edward L. Tobinick" in 09/275,070 (and "Edward L. Tobinick, M.D." in 09/476,643).

53. Exhibit 14 is another copy of the inventor declaration. Page 2 is transmittal letter dated "FEBRUARY 24, 1999 BY EXPRESS MAIL" listing the filing of an inventor declaration, and specification. Page 3 of Exhibit 14 is the first page of the specification as filed.

54. Exhibit 15, pages 1 - 2 is a Notice of Abandonment "mailed 09/27/99." Exhibit 15, page 3 is communication by applicant dated 9/16/99 stating: "Re: S.N. 09/256,388 Applicant hereby abandons the above-identified application in favor of Appln. S.N. 09/275,070, which has been allowed by Examiner Jarvis."

55. **The foregoing show that the USPTO records show that application 09/256,388 was filed on February 24, 1999 and abandoned on Sept. 16, 1999.**

#### **F. FACTS WHY THE REQUESTED RELIEF IS NOT MOOT**

56. Pending Tobinick application 12/714,205 claims priority to the subject application 09/826,976 (US 6,419,944) as follows: "This is a continuation of application Serial No. 11/262,528, filed on Oct. 28, 2005, which is a division of application Ser. No. 10/269,745, filed Oct. 9, 2002, now U.S. Pat. No. 6,982,089, which is a continuation-in-part of application Ser. No. 09/841,844, filed on Apr. 25, 2001, now U.S. Pat. No. 6,537,549, which is a continuation-in-part of **application Ser. No. 09/826,976, filed on Apr. 5, 2001, now U.S. Pat. No. 6,419,944, which is a continuation-in-part of application Ser. No. 09/666,068, filed Dec. 11, 2000, now U.S. Pat. No. 6,379,666, which is a division of application Ser. No. 09/476,643, filed on Dec. 31, 1999, now U.S. Pat. No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/275,070, filed on Mar. 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned.**" (emphasis added)

#### **G. FACTS SHOWING THE FAILURE TO PROPERLY CLAIM BENEFIT WAS UNINTENTIONAL**

57. The foregoing facts 1 - 56 show that failure to claim in this application priority to 09/666,068 was an unintentional clerical error.

#### **H. FACTS RELATING TO THE LEGAL STANDARD FOR ENTRY OF CORRECTION OF BENEFIT CLAIMS**

58. Exhibit 16 is a copy of pages from Section 1481.03 of the current version of the MPEP.

## **I. RELATED USPTO PROCEEDINGS**

59. The applicant is presenting herewith an Amendment to correct benefit in the subject application 09/826,976..
60. The applicant is filing herewith a corresponding request for a Certificate of Correction in the patent that issued from the '976 application, i.e., U.S. Pat. 6,419,944.

## **III. REASONS WHY THE PETITION SHOULD BE GRANTED**

On the merits, the petition should be granted because (1) the relief requested is not moot; (2) an amendment as to benefit in an issued application is submitted herewith, (3) all of the elements required under 37 CFR 1.78(a)(3) have been presented, so awarding a corrected priority chain in application Ser. No. 09/826,976 is proper, and (4) a request for the appropriate Certificate of Correction has been filed.

### **A. STANDARD FOR GRANT OF PETITION**

#### **1. FORMAL MATTERS**

The petition filed herewith requests entry of an amendment in an issued application filed after November 29, 2000. Therefore petition under Rule 1.78 is proper.

(CX13 "Eighteen-Month Publication Questions and Answers"

<http://www.uspto.gov/patents/law/aipa/18month/18monthfaq.jsp#cx>)

The applicant is paying the 37 CFR 1.17(t) fee therefore via credit card upon EFS web submission of this petition.

#### **2. THE PETITION IS NOT MOOT**

The petition is not moot because, even though 09/826,976 is issued, a pending application claims priority to this application. Fact 56.

#### **3. CRITERIA FOR CORRECTION OF BENEFIT**

The amendment and accompanying petition is to correct benefit. The requirements to obtain benefit and to correct benefit are governed by Rule 1.78. MPEP 1481.03 contains criteria for granting a Certificate of Correction correcting benefit in an issued patent. See the section titled

"Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits." In view of the foregoing, this petition shows compliance with the criteria for correction of benefit under Rule 1.78.

**B. THE APPLICANT HAS COMPLIED WITH THE CRITERIA FOR CLAIMING BENEFIT TO 09/666,068**

**1. THE APPLICANT HAS COMPLIED WITH THE REQUIREMENTS OF 37 C.F.R. 1.78**

The following paragraphs in this subsection identify requirements in Rule 1.78 for claiming priority, and show compliance with those requirements.

37 CFR 1.78(a)(1) authorizes a claim to priority to prior filed applications only if the applications name at least one common inventor and disclose the claimed invention. The prior filed application is 09/666,068. The common inventor is Edward L. Tobinick, M.D. Facts 14-40.

37 CFR 1.78(a)(1)(i) and (ii) require the prior filed applications to be either international applications or applications entitled to a filing date. The prior filed application is 09/666,068, which was entitled to and accorded a filing date. Exhibit 1, Facts 30-31

37 CFR 1.78(a)(2)(i) requires a claim to priority to be present or amended to be present during the pendency of the application, unless the application was filed prior to November 29, 2000, and to state the relationship between the applications. This application is an application filed under 111(a) after November 29, 2000. Accordingly, the amendment submitted herewith provides the specific references and relationship (CIP) of 09/666,068, which is itself a divisional of application Ser. No. 09/476,643, which is a continuation-in-part of 09/275,070, which is a continuation-in-part of 09/256,388.

37 CFR 1.78(a)(2)(iii) requires the claim to priority be presented in an application data sheet or amendment to the first sentence of the specification following the title. The amendment submitted herewith provides the claim to priority to 09/666,068 in the first sentence of the specification following the title.

37 CFR 1.78(a)(3) authorizes an amendment claiming priority after the time periods specified by 1.78(a)(2)(ii) only if the late filing of the claim the priority was unintentionally

delayed. The entire delay between the date the priority claim was due under paragraph 37 CFR 1.78 (a)(2)(ii) and the date of submission of this Petition was unintentional. Fact 57.

37 CFR 1.78 contains no other requirements applicable to grant of this petition. In view of the foregoing, this petition should be granted.

**DATE:** 6-10-2010

**SIGNATURE:** /RobertHahl#33,893/

**PRINTED NAME:** Robert W. Hahl, Ph.D.